



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,057	04/03/2002	Seiko Hirano	221519USOPCT	6859

22850 7590 01/11/2005

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

NAVARRO, ALBERT MARK

ART UNIT PAPER NUMBER

1645

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/089,057	HIRANO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Mark Navarro	1645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-48 and 50-59 is/are pending in the application.
- 4a) Of the above claim(s) 1-44, 47 and 48 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 46, 51, 53, 55, 57 and 59 is/are allowed.
- 6) ☒ Claim(s) 45, 50 and 54 is/are rejected.
- 7) ☒ Claim(s) 52, 56 and 58 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Applicants amendment filed October 12, 2004 has been received and entered. Claim 49 has been canceled and new claims 50-59 have been added. Consequently, claims 1-48 and 50-59 are pending in the instant application, of which claims 1-44, and 47-48 have been withdrawn from further consideration as being drawn to a non-elected invention.

This application contains claims 1-44 and 47-48 drawn to an invention nonelected with traverse. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. The rejection of claims 45 under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter is maintained.

It is noted that Applicants have amended claim 46 to recite isolated DNA and accordingly this rejection is withdrawn from claim 46. However, while Applicants have argued that such an amendment was made to claim 45, no such amendment has been made. Accordingly this rejection as applied to claim 45 is maintained.

Claims 45 is directed to nucleic acids which have the same characteristics and utility as nucleic acids found naturally and therefore does not constitute as patentable subject matter.

In the absence of the hand of man, naturally occurring products are considered non-statutory subject matter. Diamond v. Chakrabarty, 206 USPQ 193 (1980). Mere purity of naturally occurring product does not necessarily impart patentability. Ex parte Siddiqui 156 USPQ 426 (1966). However when purity results in new utility, patentability is considered. Merck Co. V. Chase Chemical Co. 273 F. Supp 68 (1967). See also American Wood v. Fiber Disintergrating Co., 90 US 566 (1974); American Fruit Growers v. Brogdex Co. 283 US 1 (1931); Funk Brothers Seed Co. V. Kalo Innoculant Co. 33 US 127 (1948). Filing of evidence of a new utility imparted by the increased purity of the claimed invention and amendment to the claims to recite the essential purity of the claimed products is suggested to obviate this rejection. For example, "An isolated nucleic acid..."

2. The rejection of claims 45-46 and 49 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, a written description rejection is withdrawn in view of Applicants amendment.

3. The rejection of claims 45-46 and 49 under 35 U.S.C. 112, second paragraph, as being vague and indefinite in the recitation of "the amino acid sequence of SEQ ID NO: 80" is withdrawn in view of Applicants submission of a corrected electronic copy of the sequence listing.

4. The rejection of claim 46 is rejected under 35 U.S.C. 112, second paragraph, as

Art Unit: 1645

being vague and indefinite in the recitation of “stringent condition” is withdrawn in view of the amendment to the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The rejection of claims 45-46 and 49 under 35 U.S.C. 102(b) as being anticipated by Eikmanns et al is withdrawn in view of Applicants submission of a corrected electronic sequence listing.

The following new grounds of rejection are applied to the claims:

***Claim Rejections - 35 USC § 112***

6. Claims 50 and 54 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an isolated DNA encoding SEQ ID NO: 80, does not reasonably provide enablement for an isolated DNA encoding SEQ ID NO: 80 including substitutions, deletions, insertions, additions or inversions of 1-10 amino acids. The specification does not enable any person skilled in the art to which it pertains, or

Art Unit: 1645

with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Facts that should be considered in determining whether a specification is enabling, or if it would require an undue amount of experimentation to practice the invention include: (1) the quantity of experimentation necessary to practice the invention, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. See In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1403 (Fed. Cir. 1988). The Federal Circuit has noted, however, that only those factors that are relevant based on the facts need to be addressed. See Enzo Biochem. Inc. v. Calgene, Inc. 188 F.3d 1362, 1371, 52 USPQ2d 1129, 1135 (Fed. Cir. 1999).

Rudinger (Peptide Hormones, University Park Press, June 1976) teaches that “The significance of particular amino acids and sequences for different aspects of biological activity cannot be predicted *a priori* but must be determined from case to case by painstaking experimental study.”

Considering the facts of the Wands analysis above, the quantity of experimentation necessary to practice the claimed invention is “painstaking” as set forth by Rudinger. Further, working examples outside of the disclosed SEQ ID NO: 80 are not present. Furthermore, the nature of substituting amino acids within a protein is highly unpredictable in the effect it has on biological activity, also as set forth by the teachings of Rudinger.

Given the lack of guidance, lack of working examples, amount of painstaking

Art Unit: 1645

experimentation and the unpredictable results of substituting amino acids on biological activity, one of skill in the art would be forced into excessive experimentation to practice the broadly claimed invention.

Claims 52, 56, and 58 are objected for depending upon a rejected base claim, however claims 52, 56 and 58 are free of the prior art of record.

Claims 46, 51, 53, 55, 57 and 59 are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 1645

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Navarro whose telephone number is (571) 272-0861. The examiner can normally be reached on 5/4/9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on (571) 272-0864. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mark Navarro  
Primary Examiner  
January 6, 2005